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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,293	08/14/2006	Debbie Stevens-Wright	B1075.71014US01	1875
23628 7590 10/08/2010 WOLF GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210-2206				
EXAMINER				
LEE, BENJAMIN HYOUNGSOI				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,293

Applicant(s)

STEVENS-WRIGHT ET AL.

Examiner

BENJAMIN LEE

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,11-13,16-17,19 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7,11-13,16,19 and 33 is/are rejected.
- 7) ☒ Claim(s) 4 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 1, 3, 5-7 and 33 is withdrawn in view of the newly discovered reference(s) to Eggers et al. (5,178,620). Rejections based on the newly cited reference(s) follow. This action is non-final.
2. **Claims 4 and 17** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Objections

3. **Claim 16** is objected to because of the following informalities: The phrase "the first ablation electrode" and "the second ablation electrode" in line 3 should be amended to --a first ablation electrode-- and --a second ablation electrode--. The phrase "a first ablation electrode" in line 6 should be amended to --the first ablation electrode--. The phrase "a second ablation electrode" in line 8 should be amended to --the second ablation electrode--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 3, 5-7, 11, 16, 19 and 33** are rejected under 35 U.S.C. 102(b) as being anticipated by Eggers et al. (5,178,620).

As to claim 1, Eggers discloses a catheter in Fig. 3 comprising: a longitudinal catheter shaft 1 for positioning an ablation electrode 3 within a patient's body; and an ablation electrode 2 disposed on the shaft (e.g. on the end) and having an outer ablating surface (see Fig. 3), wherein the electrode is convertible from a first configuration in which the electrode outer ablating surface has a first axial size and a first radial size to a second configuration in which the electrode outer ablating surface has a second axial size and maintains the first radial size since the electrode 2 advances (col. 6, lines 24-26); wherein the ablation electrode comprises a first electrode portion 3 and a second electrode portion 2, the first electrode portion having an outer ablating surface (see Fig. 3), and the second electrode portion having a length and being moveable in the axial direction of the catheter since the electrode 2 advances (col. 6, lines 24-26), wherein in the first configuration more of the second electrode portion length is contained within the first electrode portion than in the second configuration since when the electrode 2 advances more of electrode 2 is exposed (e.g. 2nd configuration, col. 6, lines 24-26). Note that the claim does not specifically require the electrode to coaxially surround the shaft, but only be "disposed on the shaft" which is broad.

As to claim 3, in the first configuration, the second electrode portion length is capable

of being fully contained within the first electrode portion (e.g. may be pulled back).

As to claim 5, Eggers discloses a pull wire is connected to the second electrode portion since the electrode 2 may be connected to a guide wire (col. 4, lines 63-65).

As to claim 6, Eggers discloses the ablation electrode is a ring electrode (see Fig. 3).

As to claim 7, Eggers discloses the first electrode portion and the second electrode portion are cylindrical (see Fig. 3).

As to claim 11, Eggers discloses a catheter in Fig. 3 comprising: a longitudinal catheter shaft 1 for positioning an ablation electrode within a patient's body; and an ablation electrode 2 and 3 having an electrode length and disposed on the shaft, the electrode having a continuous outer ablating surface area with an outer ablating surface area length (see Fig. 3), and the electrode having portions which are movable relative to one another since electrode 2 may be advanced (col. 6, lines 24-26) and which stay in electrical contact with one another (via electrical lead, see col. 5, lines 51-54); wherein the continuous outer ablating surface area length is adjustable since electrode 2 may be advanced (col. 6, lines 24-26); the ablation electrode length is adjustable since electrode 2 may be advanced (col. 6, lines 24-26); and the electrode is substantially comprised of metal (see claim 27 in the patent).

As to claim 16, Eggers discloses a catheter comprising: a longitudinal catheter shaft configured to position an ablation electrode within a patient's body, wherein the first ablation electrode portion and the second ablation electrode portion are mounted on the catheter shaft (see Fig. 3); a first ablation electrode portion 3 configured for mounting on the catheter shaft (see Fig. 3), the first ablation electrode portion 3 having an outer

ablating surface configured to emit electrical energy (see Fig. 3); and a second ablation electrode portion 2 configured for mounting on the catheter shaft (e.g. mounted on the distal end), the second ablation electrode portion having an outer ablating surface configured to emit electrical energy since it is an electrode (col. 4, lines 60-65); wherein the second ablation electrode portion 2 is moveable from a first position substantially inside the first ablation electrode portion 3 to a second position substantially outside the first ablation electrode portion 3 since it advances (col. 6, lines 24-26); and the first ablation electrode portion 3 and the second ablation electrode portion are electrically connected (col. 5, lines 51-54).

As to claim 19, Eggers discloses a pull wire configured to move the second electrode portion since the electrode 2 may be connected to a guide wire (col. 4, lines 63-65).

As to claim 33, Eggers discloses the first electrode portion is in electrical contact with an electrical lead, and the second electrode portion is in electrical contact with the same electrical lead (col. 5, lines 51-54).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. **Claims 12-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al. (5,178,620), In view of Eggers (5,810,764).

As to claim 12, Eggers '620 does not expressly teach that the electrode is substantially comprised of at least one of platinum, silver, gold, chromium, aluminum and tungsten. However, Eggers '764 teaches that electrodes for ablation comprise electrically conducting materials such as alloys containing one or more of platinum, chromium, aluminum or tungsten (col. 22, lines 49-53). It would have been obvious to

one of ordinary skill in the art at the time of the invention to implement the electrode of Eggers '620 such that it substantially comprised of at least one of platinum, silver, gold, chromium, aluminum or tungsten since suitable metallic materials for an ablation electrode is recognized in the art, as exemplified by the teachings of Eggers '764 (col. 22, lines 49-53).

As to claim 13, Eggers '620 does not expressly teach that the electrode is substantially comprised of a combination of at least two of: platinum; silver; gold; chromium; aluminum and tungsten. However, Eggers '764 teaches that electrodes for ablation comprise electrically conducting materials such as alloys containing one or more of platinum, chromium, aluminum or tungsten (col. 22, lines 49-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the electrode of Eggers '620 such that it substantially comprised of a combination of at least two of platinum, silver, gold, chromium, aluminum or tungsten since suitable metallic combinations for an ablation electrode is recognized in the art, as exemplified by the teachings of Eggers '764 (col. 22, lines 49-53).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN LEE whose telephone number is (571)270-1407. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571)-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. L./ 10/1/2010
Examiner, Art Unit 3739

/Linda C Dvorak/
Supervisory Patent Examiner, Art
Unit 3739